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|--|-------------|----------------------|---------------------|------------------|
| 09/352,949   | 07/14/1999  | KAZUYUKI MURATA      | 50023-107           | 2823             |
| 20277  | 7590        | 04/21/2004           | EXAMINER            |                  |
| MCDERMOTT WILL & EMERY<br>600 13TH STREET, N.W.<br>WASHINGTON, DC 20005-3096 |             |                      | ✓ TRAN, DOUGLAS Q   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2624                | 22               |

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/352,949

Applicant(s)

MURATA ET AL.

Examiner

Douglas Q. Tran

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. The request filed on 2/11/04 for a Request For Continued Examination (RCE) Pursuant to 37 CFR 1.114 based on the Application Serial No. 09/378,322.

Applicant's arguments filed 2/11/04 have been fully considered but they are not persuasive. The Examiner still keep the same previous rejection to the RCE follows:

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hosotsubo (US Patent No. 6,009,485) and Tabata (US Patent No. 6,198,542 B1).

As to claim 1, Hosotsubo teaches: an image data distribution system wherein the image data will be sent out to the respective members of the destination group specified by the destination information (col. 1, lines 41-44) via a network (21 in fig. 2, col. 6, lines 21-26), the system comprising:

Input manipulation means (24 in fig. 10), provided in the digital multifunction apparatus (i.e., an input device such as host computer 22 in fig. 2), which can request the controller (i.e., the CPU 34 in fig. 2) to send back all the destination groups, and specify a specific group from

Art Unit: 2624

among all the destination groups sent back from the controller and the memory (col. 5, lines 5-13), and send to the controller and the memory (col. 5, lines 5-13) at least the specified group together with a group registration request to register the digital multifunction apparatus with the specified group after specifying the group (it is noted that a user inputs for registering from S11 to S15 in fig. 4, col. 5, lines 40-42 and 66 to col. 6, line 2; and the specified group or groups stored in 25 in fig. 2 and S16 in fig. 4, col. 6, line 55 to col. 7, line 12),

(It is noted that: 1) since the digital multifunction apparatus has a function for requesting the information from the server or output device via the network, the digital multifunction apparatus would be considered as a digital computer such as the host computer because the host computer has the same function as the digital multifunction apparatus;

2) with respect to col. 5, lines 25-31, ID and user name is registered with each of printers 1 connected to the host computer on the predetermined network 21. Thus, the user would be considered as the computer registered with each of printers. And, the predetermined network 21 is determined for connected with all the destination groups including group of section/department or floor names "col. 5, lines 58-65". The registered computer would be registered with a group of printers or a group of the host computers in highlight installed on the designated floor "col. 6, lines 63-65" and figure 9 shows the computers (or the user names) are specified on the group of floor 5F. Therefore, the e-mail or voice mail can be distributed from one registered host computer to the specified group of computers in the network "col. 6, lines 51-54" and the print information can be distributed from the registered computer to the specified group of printers "col. 7, lines 5-11"),

the controller (i.e., the CPU 34) sends to the user all the destination groups according to the request sent from the user and registers the digital multifunction apparatus (i.e., the computer in which the user inputs the command for registering) with the specified destination group (it is noted that a group registration means such as RAM 31 for registering specific users as a specific group; and the controller (i.e., the CPU 34) for controlling to provide and register the destination id to the specified group from all the destination groups based on the user command “col. 5, lines 24-31”).

However, Hosotsubo does not explicitly teach the plurality of digital multifunction apparatus (or the functionalities of the host computer) communicate with the image server via the network.

Tabata teaches the server (1 in fig. 1) provides an information group list (fig. 5) to an input device such as the host computer (3 in fig. 3) (col. 6, lines 31-44 and col. 7, lines 46-50) (it is noted that the server 1 would be the output device which connects the plurality of the input devices such as the host computers “3, 4 in fig. 1”, the plurality of digital multifunction apparatus (i.e., copying machine 6 and/or multifunctional machine 7 in fig. 1. Thus, if any of devices such as the digital multifunction apparatus “6 or 7 in fig. 1” connected to the server and has the function like a host computers 3, 4 for requesting the information from the server, then the server would inherently distribute the requested information to that device).

It would have been obvious to modify the communication system of Hosotsubo for providing an information group list from a server to the host computer as taught by Tabata. The suggestion for modifying the system of Hosotsubo can be reasoned by one of ordinary skill in the art as set forth by Tabata because the modified system of Hosotsubo would increase the

Art Unit: 2624

efficiency by having a server to store and provide any information of the output devices to a host and allows a user easily to keep track information in a group of the output devices and select a designed output devices in the group. Such resultant systems allow the computer to perform any other functions in high speed because the computer does not have to store and process the register with other apparatuses.

As to claim 3, Hosotsubo and Tabata teach every feature in claim 1, and Hosotsubo teaches that the digital multifunction apparatus (as discussed in claim 1, the digital multifunction apparatus would be considered as the input device such as the host computer 22 in fig. 2) is provided with image input means (i.e., a display unit 24 in fig. 2) for reading a document and sends image data from the image input means to the image server (i.e., col. 3, line 66 to col. 4, lines 1, and 29-33: the display unit 24 for reading the image data and outputting for printing; col. 3, lines 56-62: the computer connected to each other through a predetermined network including a server which is combined with the teaching of Tabata and discussed in claim 1).

As to claim 4, Hosotsubo and Tabata teach every feature in claim 1, and Hosotsubo teaches that the digital multifunction apparatus (as discussed in claim 1, the digital multifunction apparatus would be considered as the input device such as the host computer 22 in fig. 2) is provided with storage means (i.e., 31 in fig. 2) for storing image data and sends image data from the storage means to the image server (col. 4, lines 29-33: image data is stored in RAM for printing at the output device; col. 3, lines 56-62: the computer connected to each other through a predetermined network including a server which is combined with the teaching of Tabata and discussed in claim 1).

As to claim 5, Hosotsubo and Tabata teach every feature in claim 1, and Tabata teaches that the digital multifunction apparatus (digital multifunction apparatus “7 in fig. 3” would be considered as the input device such as the host computer) is provided with facsimile transmit-receive means (17 in fig. 3) and sends image data from the facsimile transmit-receive means to the image server (1 in fig. 1, it is noted that the multifunction machine 7 would be well known in the art to have a facsimile function, thus, it has a facsimile transmitting means for sending the image data to any of the connected output device such as the image server 1 in fig. 1).

As to claim 12, the combination of Tabata and Hosotsubo teaches that the method is performed by the apparatus claim 1 as indicated above.

### ***Response to Arguments and Amendment***

Applicant's arguments filed 2/11/04 with respect to claims 1, 3-5, have been fully considered but they are not persuasive. This action is made **non-final**.

Applicant argued that “Hosotsubo relates to apparatus and method of forming a new group while the present invention relates to apparatus and method of assigning a new terminal to one of plural groups registered in the server by using the new terminal. Assigning a new terminal to one of plural groups registered in the server by using the new terminal clearly distinguishes the claimed invention from anything disclosed in the applied prior art references”. In reply, Hosotsubo clearly teaches the registering for the new information of the host computer to the specified destination group. Col. 5, lines 25-31, ID and user name is registered with each of printers 1 connected to the host computer on the predetermined network 21. Thus, the user would be considered as the computer registered with each of printers. And, the predetermined network

Art Unit: 2624

21 is determined for connected with all the destination groups including group of section/department or floor names "col. 5, lines 58-65". The registered computer would be registered with a group of printers or a group of the host computers in highlight installed on the designated floor "col. 6, lines 63-65" and figure 9 shows the computers (or the user names) are specified on the group of floor 5F. Therefore, the e-mail or voice mail can be distributed from one registered host computer to the specified group of computers in the network "col. 6, lines 51-54" and the print information can be distributed from the registered computer to the specified group of printers "col. 7, lines 5-11".

col. 5, lines 57-65: the user's post "i.e., the specified group" such as assistant section manager, section manager, department manager, office manager, or head office manager to which a user belongs may be registered.

Therefore, the host computer (or the user), which be considered as the multifunction destination, is registered with the specified group of the computers for receiving the email (col. 6, lines 51-54).

a group registration means such as RAM 31 for registering specific users as a specific group; and the controller (i.e., the CPU 34) for controlling to provide and register the destination id to the specified group from all the destination groups based on the user command (col. 5, lines 24-31).

A server includes a controller, and the server controller can have the same function as the controller 34 at the computer for providing the entire destination groups and registering the information of from the requested user.



Art Unit: 2624

Furthermore, Tabata teaches a server provides an information group list to the host computer after requesting of the user (Fig. 5, col. 6, lines 31-44 and col. 7, lines 46-50).

For the above reasons, it is believed that the cited prior art fully discloses the claimed invention and the rejection stand.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran  
Apr. 17, 2004

A handwritten signature in black ink, appearing to read "Tran Douglas", with a long horizontal flourish extending to the right.